

R E M A R K S

This is in response to the Office Action that was mailed on July 29, 2003. Applicant gratefully acknowledges the Examiner's indication of allowable subject matter. Allowable claims 44-49 are amended to be independent of rejected claims. Claim 30 is cancelled, without prejudice to its subject matter, nor to its reassertion in this or a continuing application. The recitations of claims 34 and 41 are incorporated into claim 31. Corresponding amendments to dependencies are made to claims 35-37 and 42 and 43, respectively. Claims 44 and 45 have been recast in independent form. No new matter has been introduced. Favorable action on the merits of claims 31-33, 35-40, and 42-51 as amended is respectfully solicited.

Restriction was required between (I.) claim 30, drawn to a method for the preparation of paper pulp, and (II.) claims 31-51, drawn to an apparatus for practicing the invention of Group (I.). Solely to be responsive to the Office Action, Applicant had elected the invention of Group (II.), with traverse. In the Office Action of December 19, 2003, the Examiner maintains the requirement for restriction. In order to expedite the prosecution of this application, Applicant has cancelled claim 30. However, Applicant retains the right to pursue method claims in a divisional application.

Claims 32-51 (? 31-51) were rejected under the second paragraph of 35 U.S.C. §112, apparently due to their dependence on a method claim. While Applicant does not agree that this made the claims indefinite, the reference to the method claim has been removed from claims 31-51, solely in order to advance the prosecution of this application.

Claims 31-43, 50, and 51 were rejected under U.S.C. §103(a) as being unpatentable over DE 29 24 794 B1 (Voith, incorrectly referred to in the

Office Action as "EP 29 24 794") in view of US 5,257,698 (Christ) and US 4,443,331 (Amand) or US 5,131,544 (Serres) or US 4,533,468 (Ensor). Claims 34 and 41 have been cancelled. Claims 31-33, 35-40, 42, 43, 50, and 51 are drawn to an apparatus that comprises a body having at least a feeding zone, a suspension-concentration zone, a clarification chamber comprising separation cones, and a preclarification chamber. The prior art as it is applied in the Office Action neither teaches nor suggests an apparatus with such features.

The prior art relating to recycled fiber stock preparation lines includes a multiplicity of different steps and functions, due to the fact that several categories of solids with different densities, sizes, and shapes have to be separated from pulp (e.g., sand, wood, inks, glass, glue, plastics, staples, sometimes ash). Many of the functions performed by the presently claimed apparatus are conventionality carried out by separate machines, which are connected only through pumps, pipes, tanks, etc. By providing an apparatus whose body includes at least a feeding zone, a suspension-concentration zone, and a clarification chamber comprising separation cones, the present invention makes a major contribution to recycling lines – providing considerable savings in energy, chemicals, space, and installation costs.

In stating the rejection of claims 31 etc. in their former condition over the prior art, the Examiner argues that "it would have been obvious to the routineer to further clarify the suspension of EP [sic] 29 24 794 using the clarifiers of AMAND or SERRES et al or ESNOR et al". This argument has several defects with respect to the present rejection. First, establishing by ancillary references that one of ordinary skill in the art *could* do something (such as clarify) does not establish that he or she would be *motivated* to do it in the context of the primary reference. Second, "clarifying", "separating", "cleaning", "filtering", etc. are process steps – but the present claims are apparatus claims. Even if any of the steps (such as clarifying, cleaning, etc.)


were established to be obvious and motivated – which they have not been – that would still not make it obvious to provide within the body of a sole apparatus a clarification chamber comprising separation cones and a pre-clarification chamber upstream of that clarification chamber. Third, the Amand, Serres, and Esnor references are concerned with apparatuses more designed to clean (i.e., to separate selective solids using their density properties) than to clarify (i.e., to separate total suspended solids from water). Fourth, Esnor teaches an apparatus that would probably not be useable for pulp applications, as there is no possible separation between “heavy particles” and cellulose fibers. The rejection of record is not sustainable.

Should there be any outstanding issues that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at the (703) 205-8008.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,
BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

 #32868
f Raymond C. Stewart, #21,066

RCS/RG 

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000